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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER M. TOBIN, PHILIP MICHAEL ABRAM,
MARC BECKWITT, GREGORY D. GUDORF, KAZUAKI ISO, BRIAN
RAYMOND, and BRIAN M. SIEGEL

Appeal 2009-001987
Application 09/873,067¹
Technology Center 2100

Before JOHN A. JEFFERY, JAY P. LUCAS, and JAMES R. HUGHES,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL²

¹ Application filed June 1, 2001. Appellants claim the benefit under 35 U.S.C. § 119 of provisional application 60/208,847, filed June 2, 2000. The real parties in interest are Sony Electronics and Sony Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 17 to 40 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). Claims 1 to 16 are cancelled.

We affirm the rejections.

Appellants' invention relates to navigating web pages using an assistant (Spec. ¶ [0002]). In the words of Appellants:

[T]he navigation assistance application [provides] information supplemental to that displayed on a web page. The supplemental information is not merely additional information that may have been provided along with the current web page, such as detailed link information that may appear along the bottom of a browser display window upon hyperlink rollover; rather, it is preferably information stored separately from the web page, and information that is particularized to the user. Typically, the information will be provided in a local database that associates identifiable web resources to various supplemental information. Thus, for example, consumer incentive information related to available resources and particularly associated to the user can be displayed.

(*Id.* at ¶ [0026]).

The following illustrate the claims on appeal:

Claims 17 and 23:

17. A method of displaying supplemental information particular to a user regarding displayed web pages for the user, the method comprising:

identifying a particular product displayed in a first web page using a device that displays the first web page to the user;

determining, with the device, whether an entry corresponding to the particular product displayed on the first web page is contained in a database on the device, wherein the database comprises supplemental information particular to a user and correlates the supplemental information to each of a plurality of products, and wherein the database is separate from the first web page and the first web page is ordinarily devoid of the supplemental information; and

displaying supplemental information correlated to the particular product along with and separate from the first web page if it is determined that the database contains an entry for the particular product.

23. An apparatus for displaying supplemental information particular to a user regarding displayed web pages for the user, the apparatus comprising:

a link assessment module, for identifying a particular product displayed in a first web page using a device that displays the first web page to

the user and determining, with the device, whether an entry corresponding to the particular product displayed on the first web page is contained in a database on the device, wherein the database comprises supplemental information particular to a user and correlates the supplemental information to each of a plurality of products, and wherein the database is separate from the first web page and the first web page is ordinarily devoid of the supplemental information; and

a supplemental information display module, in communication with the link assessment module, for displaying supplemental information correlated to the particular product along with and separate from the first web page if it is determined that the database contains an entry for the particular product.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Harris	US 6,014,635	Jan. 11, 2000
Revashetti	US 6,230,199 B1	May 08, 2001 (filed Oct. 29, 1999)
Jakobson	US 6,697,838 B1	Feb. 24, 2004 (filed May 03, 2000)

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 23 to 28 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

R2: Claims 17, 18, 21 to 24, 27 to 30, 33 to 36, 39, and 40 stand rejected under 35 U.S.C. § 103(a) for being obvious over Jakobson in view of Revashetti.

R3: Claims 19, 20, 25, 26, 31, 32, 37, and 38 stand rejected under 35 U.S.C. § 103(a) for being obvious over Jakobson in view of Revashetti and Harris.

We will review the rejections in the order argued, and as grouped in the Briefs. We have only considered those arguments that Appellants actually raised in the Briefs. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

The issues involve whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. §§ 101 and 103(a). The issue under 35 U.S.C. § 101 specifically turns on whether the claimed “link assessment module” and claimed “supplemental information display module” (claim 23) are software *per se*. The issue under 35 U.S.C. § 103(a) specifically turns on whether Appellants’ claimed “supplemental information” (claim 17) is disclosed in the Jakobson or Revashetti references.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Disclosure

1. Appellants have invented a method, apparatus, and storage medium for navigating web pages while accessing supplemental information about products displayed on a first web page. (*See* claims 17, 23, 29, and 35.) Appellants' method requires storing the supplemental information in a database separate from the web browser (§ [0028]). A first web page "is ordinarily devoid" of the supplemental information (claim 17), which is particular to a user and correlated with the products (*id.*). The Specification discloses that each "module," as recited in claim 23, is preferably "provided as software" (Spec. § [0030]).

Jakobson

2. The Jakobson reference discloses navigating web pages while accessing notes or annotations about information products displayed on one of the web pages (col. 1, ll. 8 to 13). Jakobson's notes are stored in a database separate from the web browser displaying the information products (col. 3, ll. 29 to 35). In Jakobson, the notes are only displayed when called from the database (col. 9, ll. 52 to 58). User notes are correlated with the information products of the web pages (*id.*).

Revashetti

3. The Revashetti reference discloses customizing products for users based on the users' web browsing preferences. (*See* col. 1, ll. 8 to 11 and 19 to 21; col. 21, ll. 4 to 8.)

Harris

4. The Harris reference discloses a consumer incentive available to a user and related to an item for purchase (col. 2, ll. 18 to 25; col. 2, l. 53 to col. 3, l. 6; Ans. 7, middle to bottom).

PRINCIPLE OF LAW

Appellants have the burden on appeal to the Board to demonstrate Examiner error. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

ANALYSIS

*Argument with respect to the rejection
of claims 23 to 28
under 35 U.S.C. § 101 [R1]*

The Examiner rejected the noted claims as non-statutory because the “link assessment module” and the “supplemental information display module” are software *per se*. (See Ans. 3, bottom to 4, top).

Since the Specification supports that each “module” of claim 23 can be hardware, Appellants argue that the claim is statutory (App. Br. 4, bottom to 5, top). The Examiner replies that the disclosure specifies Appellants’ “modules” may, however, be limited to only software (Ans. 8; Spec. ¶ [0030]).

“If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007). A claim to a data structure *per se* is non-

statutory. *See In re Warmerdam*, 33 F.3d 1354, 1360-61 (Fed. Cir. 1994). Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer (*id.* at 1361).

We agree with the Examiner. Although claim 23 nominally recites an “apparatus” in the preamble of the claim (a category of statutory subject matter under § 101), we nonetheless find that the claim as a whole is directed to non-statutory subject matter. That is, when construed in light of the Specification, each recited “module” of claim 23 can be implemented solely via software as the Examiner indicates (Ans. 3, 8) and is therefore neither a device, an article of manufacture, or an act being performed (*see id.*). Since the “modules” may comprise only software code (FF#1), and not any actual hardware device or apparatus, the claim as a whole does not qualify as statutory subject matter under § 101. We thus affirm the rejection R1.

*Argument with respect to the rejection
of claims 17, 18, 21 to 24, 27 to 30, 33 to 36, 39, and 40
under 35 U.S.C. § 103(a) [R2]*

The Examiner rejected the noted claims as being obvious over the Jakobson and Revashetti references, pages 4 to 6.

Appellants argue that modifying Jakobson’s notes to include Revashetti’s product advertisements changes Jakobson’s principle of operation, thus obviating the prima facie case of obviousness (App. Br. 5, bottom).

We agree with the Examiner's conclusion of obviousness for the following reasons.

"The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference," but rather "what the combined teachings of those references would have suggested." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (emphasis added).

We find that Appellants have not identified any particular principle that would be changed in Jakobson, nor have Appellants' identified how the Examiner's proffered combination would change that principle.

We carefully considered the Briefs, the Answer, the cited portions of Jakobson and Revashetti, and indeed the entire references. Despite Revashetti's disclosure of customizing products to specific users based on the users' web browsing preferences (*see* FF#3), we concentrate on Jakobson for the operative elements of exemplary claim 17. (*See In re Bush*, 296 F.2d 491, 496 (CCPA 1961) (in sustaining a multiple reference rejection under 35 U.S.C. § 103(a), the Board may rely on one reference alone without designating it as a new ground of rejection).)

We find that Appellants have invented a method, apparatus, and storage medium for navigating web pages while accessing supplemental information about the products displayed on a first web page (FF#1). Appellants' method requires storing the supplemental information in a database separate from the web browser (*id.*). The "first web page" of claim 17 "is ordinarily devoid" of the supplemental information (*id.*). The supplemental information is particular to a user and correlated with the products (*id.*).

In comparison, the Jakobson reference discloses navigating web pages while accessing notes or annotations (*i.e.*, Appellants' claimed "supplemental information") about the information products (Appellants' claimed "products") on one of the web pages (FF#2). Jakobson's notes are stored in a database separate from the web browser (*id.*). In Jakobson, the notes are only displayed when called from the database (*id.*). That is, Jakobson's web page is "ordinarily devoid," as claimed, of the notes (the claimed "supplemental information").

Reading the claim language broadly but reasonably, *see In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989), we interpret Appellants' "products" (claim 17) as being similar to Jakobson's displayed information products (*e.g.*, documents about intellectual property). We note no *Phillips*-type³ definition specifically limiting Appellants' claimed "products" to items for sale or manufacture (Spec. 2 to 17). Moreover, in light of a boom in the information services industries at the time the claimed invention was made (*i.e.*, June 2001), we find that a person of ordinary skill in the computer arts would have recognized the Jakobson web pages describing intellectual property as "products," as claimed.

For all of the above-stated reasons, we find Appellants have not demonstrated error in the obviousness rejection R2.

³ "[O]ur cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1329 (Fed. Cir. 2005) (en banc) (internal citations omitted).

*Argument with respect to the rejection
of claims 19, 20, 25, 26, 31, 32, 37, and 38
under 35 U.S.C. § 103(a) [R3]*

The Examiner rejected the noted claims as being obvious over the Jakobson, Revashetti, and Harris references, page 6.

Dependent claim 19 recites, in relevant part, “wherein the second web page correlates to a purchasable item, and the supplemental information includes a consumer incentive available to the user and relating to the purchasable item, the consumer incentive being obtained from the database and not being ordinarily evident from the web page.”

Appellants argue that since Harris discloses providing a discount credit based transition network, Harris cannot meet the limitations of claim 19 (App. Br. 6, middle to bottom).

Appellants merely paraphrase the claim language in forming the above-stated argument (App. Br. 6, middle to bottom). In doing so, we find Appellants have not demonstrated the non-obvious distinctions over the cited prior art in accordance with *In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991). Accordingly, we affirm the rejection R3.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not demonstrated that the Examiner erred in the rejections R1 to R3 of claims 17 to 40.

DECISION

We affirm the Examiner’s rejections R1 to R3 of claims 17 to 40.

Appeal 2009-001987
Application 09/873,067

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb

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